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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,766	09/04/2003	David Lee Black	2967/1	6919

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EXAMINER
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NGUYEN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/654,766

Applicant(s)

BLACK, DAVID LEE

Examiner

Kimberly D. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Amendment*

1. Acknowledgment is made of Amendment filed July 25, 2005.

### *Claim Objections*

2. Claims 1-2 and 6 are objected to because of the following informalities:

Re claim 1, line 1: Substitute "A optical disk" with "An optical disk".

Re claims 2 and 6, lines 1-2: The phrase "the data **includes** statistics, audio, ..." is not permitted, because in its independent claim (claim 1) the data is narrowly defined as "the data selected from the group **consisting of** statistics, audio, video, a secret data area, and an interactive area". The phrase "the data **includes** statistics, audio, ...", in claim 2 and claim 6, further broadens the claim language of its independent claim by using the transitional term "comprises" instead of "consisting of" as set forth in the independent claim 1, which is not permitted. For the purpose of examination, the examiner respectfully interprets the phrase "the data **comprises** statistics, audio, ..." as "the data **consisting of** statistics, audio, ..." (See MPEP 2111.03 [R-2])

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-5 and 7-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashina, Osamu (JP 10-138667-A) in view of Clark (US 6,511,731).

Re claims 1-2, 13-16, 18-20: Yamashina teaches an optical disk trading card (1 in fig. 1, paragraph 13), comprising

a planar disk (1) having a non-data side (fig. 1a), a data side (fig. 1b), and an outside baseball player rectangular shape related to a subject matter of the disk (paragraphs 14 and 18-22);

text and graphics applied to the non-data side to identify the disk as a trading card, the text and graphics identifying the subject matter of the disk (“Fig. 1(a) is the front printing surface of trading card 1.” paragraphs 19-22); and

at least one element (2 in fig. 1b) of data recorded on the data side (fig. 1b) of the optical disk (1), the data selected from the group consisting of statistics, audio, video, a secret data area, and an interactive area (“...the circular recording part 2 which recorded information (for example, image information, aural information or game information)...” paragraph 22, lines 1-4); the at least one element of data related by subject matter to the text and graphics applied to the non-data side of the disk (“...which has the association in the content of the front side printing surface...” paragraph 22, lines 1-7).

Yamashina fails to specifically teach the outside perimeter edge, of the trading card, having an irregular, non-circular shape.

Clark teaches an optical card (30, 40, 50 in figs. 6, 7, 8 respectively) having outside perimeter edge an irregular, non-circular shape, such as a star shape as shown in figure 7, an automobile in figure 8, or “a optical disk which has been cut down in size so that two of the

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opposing sides are parallel, and the other two opposing sides are convex” (col. 1, lines 21-23) (see figs. 6-8; col. 1, lines 16-28; col. 2, lines 29-31; col. 5, lines 23-26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate optical disk having irregular shape(s) as taught by Clark to the teaching of Yamashina in order to employ an optical trading card having irregular shapes, such as a star, automobile shape as shown in figures 7-8, to further promote the trading card for business advertising purposes (col. 1, lines 16-18).

Re claim 3: Yamashina teaches the optical trading card (1) further comprising a hole (3 in fig. 3) for receiving the spindle of a CD playback device (paragraphs 43-45).

Re claims 4 and 9: Although, Yamashina teaches the printing surface, which is printed on the front-surface/non-data-side of the disk (paragraphs 19 and 21).

Yamashina fails to specifically teach the text and graphical material is silk screened onto the non-data side of the disk.

Clark teaches the text and graphical material is silk screened onto one side of the disk (col. 1, lines 47-60; col. 2, lines 10-67).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the silk screening process onto the disk as taught by Clark to the teachings of Yamashina in order to avoid the hole in the center of the disk to allow the text and/or graphical design to be on a unitary design wherein the hole is completely covered and invisible (col. 1, lines 47-52 and col. 2, lines 51-56).

Re claims 5, 7-8, 10-11: Yamashina fails to specifically teach or fairly suggest the text and graphical material is on an adhesive label, which is applied to the non-data side of the disk

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(as set forth in claim 5); wherein the adhesive label is foil or paper (as set forth in claims 7 and 8, respectively); wherein the adhesive label having a plurality of intersecting slits positioned over the hole of the disk (as set forth in claim 11).

Clark teaches a label (10A, 10B, 10C in figs. 6-8) having text and/or graphics material thereon, which is adhered to the side of the disk (col. 5, lines 23-26; col. 2, lines 14-16; col. 48-50) (as set forth in claim 5); wherein the label (10) is any suitable sheet material 11, such as paper or plastic foil (col. 5, lines 1-3; col. 2, lines 26-28) (as set forth in claims 7-8); wherein the adhesive label (10) having a plurality of intersecting slits (12) positioned over the hole (23) of the disk (col. 5, lines 7-10) (as set forth in claim 11).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the adhesive label having text and/or printed material thereon to identify the subject matter of the optical disk as taught by Clark to the teachings of Yamashina in order to allow the user to easily apply the label to the side of the optical disk.

Re claims 12, 17 and 21: Yamashina teaches the optical trading card (1), which the data side comprising an annular data track (2 in figs. 1 and 3).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The examiner respectfully believes that, given its broadest reasonable interpretation, Yamashina and Clark meet the claimed invention.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

August 20, 2005



**DIANE I. LEE**  
**PRIMARY EXAMINER**